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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,609	08/01/2003	Peter Keller	188.542	4742

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EXAMINER

JOYCE, WILLIAM C

ART UNIT PAPER NUMBER

3682

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/632,609

Applicant(s)

KELLER ET AL.

Examiner

William C. Joyce

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to the Election filed August 9, 2006 for the above identified patent application.

#### ***Election/Restrictions***

1. Claims 3-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 90, 2006. Note, Applicant indicated claims 4 and 8 as reading on the elected species, however the limitation "V-shaped notch" (claim 4) and "pockets" (claim 7) are not shown in the species of Figures 5-6. It appears the V-shaped notch is shown in the species of Figure 4 with reference character 9 and the pockets are shown in the species of Figure 7 with reference character 12. Accordingly, claims 4 and 8 have been withdrawn.

2. Applicant's election with traverse of Figures 5-6 in the reply filed on August 8, 2006 is acknowledged. The traversal is on the ground(s) that all the species fall within the scope of claim 1 and should be examined together. This is not found persuasive because the species are independent or distinct because each disclosed species has a separate subject of inventive effort and therefore is considered to be diverging subject matter. The disclosed species may be classified together, but examining the diverging

subject matter of each disclosed species is considered a serious burden on the examiner. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by either Lee (USP 6,652,146) or Shiria (JP 5-126149).

Either one of Lee or Shiria discloses a linear rolling bearing comprising a guide rail and a guide carriage that partially surrounds the guide rail and is supported by rolling elements for sliding on two long sides of the guide rail, the rolling elements being arranged on each of the two long sides in at least two parallel, endlessly recirculating rows of rolling elements while a continuous spacer arrangement is inserted between every two successive rolling elements of a row, wherein, on each long side of the guide rail, a common spacer for both of said two rows is inserted between every two adjacent rolling elements of a first of said two rows and between every two adjacent rolling elements of a second of said two rows.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Lee (USP 6,652,146) or Shiria (JP 5-126149) in view of Koschmieder (DT 26 18 535).

In the event applicant amends the claims to more clearly define the spacer arrangement as illustrated in the figures, the claims would be rejected as described below.

Either one of Lee or Shiria discloses a linear rolling bearing comprising a guide rail and a guide carriage that partially surrounds the guide rail and is supported by rolling elements 9 for sliding on two long sides of the guide rail, the rolling elements being arranged on each of the two long sides in at least two parallel, endlessly recirculating rows of rolling elements while a continuous spacer arrangement is inserted between every two successive rolling elements of a row.

The prior art to Koschmieder teaches a linear rolling bearing comprising a guide rail and a guide carriage 1, rolling elements 6, and spacers 7,14 inserted between every two successive rolling elements of a row, wherein, on each long side of the guide rail, a common spacer for both of said two rows is inserted between every two adjacent rolling elements of a first of said two rows and between every two adjacent rolling elements of a second of said two rows.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the rolling element spacing device of either one of Lee or Shiria with the spacing arrangement taught by Koschmieder, motivation being to provide a modular arrangement for supporting the rolling elements at a predetermined spacing.

With respect to claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the spacers from a porous material, such as a sintered metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the spacers of Newman ('594) and Niwa et al. ('335).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Joyce whose telephone number is (571) 272-7107. The examiner can normally be reached on Monday - Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 8/19/06  
William C. Joyce